

**REMARKS**

In the Office Action, claims 1-2, 4, 6-9, 12, 14, and 16-26 were pending. Claims 1-2, 4, 6-9, 12, 14, and 16-26 were rejected. No claims have been amended by this response. Claims 1-2, 4, 6-9, 12, 14, and 16-26 remain pending.

**A. Approval of the Drawings.**

In section 1 of the Office Action, the objections to Figs. 1-3 are withdrawn, as the proposed Figs. 1-3 corrections are approved.

**B. Objection to the Specification.**

In section 2 of the Office Action, the disclosure is objected to because of the typographical error “d3evice” instead of “device”. Applicant has amended the specification as indicated by the examiner.

**C. Rejection of Claims 1-2, 4, 6-9, 12, 14, and 16-26 under 35 U.S.C. §102(e).**

In section 3 of the Office Action, claims 1-2, 4, 6-9, 12, 14, and 16-26 were rejected under 35 U.S.C. 102(e) as being anticipated by Gudjonsson et al. (hereinafter Gudjonsson) (US 6,564,261). Applicant traverses the rejection as to claims 1-2, 4, 6-9, 12, 14, and 16-26 as follows.

To anticipate a claim under 35 U.S.C. sections 102(a), (b), or (e), the reference must teach every element of the claim. (See MPEP 2131.) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California; see also MPEP 2131. "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); see also MPEP 2131.

Further any claim depending from base claims not anticipated or made obvious by the prior art are also not anticipated or made obvious by the prior art since the dependent claims comprise all of the elements of the base claims.

Gudjonsson does not teach each and every element of the independent pending claims 1, 16, and 25 as discussed below. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims.

1. Independent claim 1, and dependent claims 2, 4, 6-10 and 13.

Applicant respectfully asserts that Gudjonsson does not disclose at least the steps, claimed in claim 1, of: "terminating said data connection between said wireless communication device and the wireless communications network" and "maintaining said presence information for the user while the device remains in said active state".

Regarding the step of “terminating said data connection...”, claimed in claim 1, the Office Action states in section 1 that Gudjonsson discloses a method comprising:

“terminating said data connection between said wireless communications device and the wireless communications network (see col. 7, line 57-col. 8, line 2; col. 11, line 45-57; Fig. 8, 20, 21), where the proxy server (21, 23) provides the status of connection while the mobile device is on or active but idle;”

Applicant respectfully disagrees with this assertion. Gudjonsson does not disclose terminating the data connection. Gudjonsson, col. 7, line 57 – col. 8, line 2 discloses use of mobile phones and the Wireless Application Protocol (WAP), but it does not disclose terminating the data connection.

Gudjonsson, col. 11, lines 45-57 discloses maintaining a contact list. The contact list may show the online status of other users. “This status reflects whether a given user is currently logged in the system or not, thus giving information whether that user 7 is immediately reachable. Actually, users have a range of possible statuses they can specify, e.g., to inform other users that they are indeed online, but wish to not be disturbed or are temporarily unavailable.” Gudjonsson, col. 11, lines 52-57. The Gudjonsson status indicates whether the other users are logged into the system or not. The disclosed Gudjonsson statuses do not include “a data connection terminated but still active” status. Two other possible statuses are disclosed: (1) online but desiring not to be contacted; and (2) temporarily unavailable. Neither of these possible statuses correspond to a terminated data connection but still active.

Regarding the cited Figs. 8, 20 and 21, none of these shows terminating a data connection. Fig. 8 shows a portion of a contact list with reference to col. 11, lines 44-57. No terminating a data connection is shown.

Fig. 20 shows a logoff procedure or sequence. No terminating a data connection is shown. Specifically, "Fig. 20 shows an example of the message sequence when a user  $U_1$  logs off the backend. Now the CS 21 sends a logoff message to the US 19 responsible for  $U_1$ . The US sends status message to all subscribers, saves the user data and unloads it." . Gudjonsson, col. 27, lines 23-27. This merely describes a logoff procedure for an instant messaging system. It does not refer to terminating a data connection.

The specification defines a data connection as a voice connection in which data is sent over the voice connection. "A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers." MPEP § 2173.01. "When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. MPEP § 2173.05(a). See also MPEP § 608.01(o).

Referring again to the specification, "the user's wireless communications device is connected by a voice channel to a wireless communications network. Instant message data travels over that voice channel, in the same manner as any data traverses a voice channel between the wireless communications device and the wireless communications network. Such transmission of data on a wireless voice channel may be referred to as a 'data connection' in this document."

Specification, page 2, lines 11-16. Thus, Gudjonsson does not show terminating a data connection.

Fig. 21 also does not show terminating a data connection, for at least the reasons stated above, with reference to Fig. 20.

"Fig. 21 shows an example of the message sequence when a contact  $B_1$  logs on and off. The user  $U_1$  is watching  $B_1$  via user  $U_2$ 's contact status service. When the contact user  $B_1$  comes online, the US of user  $B_1$  sends  $B_1$ 's online status to all CSs 21 subscribed. In such a manner, a user can monitor the status of different contact users  $B$  throughout the system/network, without the contact users  $B$  knowing that their status is being monitored."

Gudjonsson, col. 27, lines 28-35. As such, Fig. 21 merely shows how user  $U_1$  can monitor whether users  $B$  ( $B_1$ , etc.) are online or not and when the users  $B$  logon or logoff. Even though logging off is shown, this is not terminating a data connection as defined by the specification and claimed in claim 1.

Regarding the step of "maintaining said presence information for the user while the wireless communications device remains in said active state", claimed in claim 1, the Office Action states in section 1 that Gudjonsson discloses a method comprising:

"maintaining said presence information for the user while the wireless communications device (11, 14) remains in said active state (see col. 3, line 1-9; col. 7, line 53-col. 8, lines 30; col. 8, lines 53-65; Fig. 8).

Applicant respectfully disagrees with this assertion. Gudjonsson does not disclose maintaining the presence information for the user while the wireless communications device remains in the active state.

"[S]aid presence information" of claim 1, step 6, refers to the presence information as it antecedent bases stated in claim 1, step 5. Thus, maintaining said presence information means maintaining said presence information indicating that the user is online. Gudjonsson does not disclose maintaining the presence information indicating that the user is online for the user while the wireless communications device remains in said active state. As described below, the active state means that the device is on, but not in a voice or data connection.

The following is an analysis of the citations and reasoning given in the Office Action. Gudjonsson discloses "dynamic user properties, called online status or user's 'presence'... contact list and contact notification, that allow users to subscribe and be notified of the online status of other users, and/or be notified of change of other user's presence information". Gudjonsson, col. 3, lines 1-9. An active state is defined by the specification in the following language:

"In one embodiment, the active state is the state of the wireless communication device 100 when that device is powered up but is not connected to the wireless communication network 200. For example, if the wireless communication device 100 is a wireless telephone, then in block 200 the telephone is turned on but no voice or data connection is made with the wireless communications network 200. As another example, if the wireless communication device 100 is a PDA, then in block 302 the PDA is turned on but is

not connected to the wireless communication network 200. When the wireless communication device 100 enters an active state, an indication that the device 100 has entered an active state is transmitted to the wireless communication network 200, as is standard. If the device 100 is in range of the network 200, the network 200 will recognize the presence of the active device 100.”

Specification p. 10, line 14 – p. 11, line 2. Thus, the active state is when the device is on but is not in a voice or data connection with the wireless communications network. Thus, the active state could be called an idle state.

As stated above, if the device is in the active state and in range of the network, the network will recognize the presence of the active device, but this is not the same presence as the claimed presence of claim 1. In claim 1, the presence claimed is “presence information indicating that the user is online”. Claim 1, step 5. Being “online” is not the same as being recognized by a wireless communications network. Alternatively stated, an active wireless communication device is not “online”. Thus, Gudjonsson does not disclose maintaining the presence information for the user while the wireless communications device remains in the active state.

Gudjonsson, col. 7, line 53 - col. 8, lines 30 discloses that access to services including instant messaging may be accomplished by the WAP and by using mobile phones, but does not disclose maintaining presence information while the wireless communication device (e.g., mobile phone) is in an active state, as described above.

Gudjonsson discloses services for allowing users “to define arbitrary sets of data related to [their] identity (this data is persisted or stored in the database 13, and this data is referred to herein as “presence” data of the user); ... to publish dynamic status information and/or presence information related to their identity (in a simple case, this status or presence might be whether the user is currently online on his/her PC or not);... to monitor the status/presence of a given set of other users 7... and be notified of any change thereof; and... to look for other user’s identity(ies) using queries by name or other useful criteria.” Gudjonsson, col. 8, lines 54-65. Again, no maintaining presence of a wireless communication device while in the active state is disclosed.

Although Gudjonsson discloses that wireless communication devices can be used in instant messaging circumstances, Gudjonsson does not disclose the maintaining of the presence information while in the active state. To the contrary, Gudjonsson says that the user can define arbitrary sets of data related to the users identity and presence, without ever mentioning a set of data or presence type that includes maintaining presence information for a wireless communication device in the active state.

Presumably, the Gudjonsson wireless communication device presence would be maintained as “online” only while in a data connection, contrary to the claimed invention. Also, presumably, the Gudjonsson wireless communication device could have an “offline” presence indicator for when the wireless communication device is not in a data connection. But this presumed “offline” state is different from the claimed presence in active state. Maintaining a (second) presence in offline state is not maintaining the presence in the active state, as

claimed. Advantageously, the claimed wireless communication device can receive instant messages, but is not wasting resources, such as, for example, network resources and battery power of the wireless communication device.

Regarding the cited Fig. 8, it does not disclose maintaining the presence information for the user while the wireless communications device remains in the active state. As stated above with reference to the claimed step of terminating the data connection, Fig. 8 shows a portion of a contact list with reference to col. 11, lines 44-57. No maintaining the (online) presence information for the user while the wireless communications device remains in the active state is disclosed.

Applicant also asserts that Gudjonsson does not disclose the claimed steps of "establishing a data connection between the wireless communication device and the wireless communications network to indicate that the wireless communications device is in an active state" and "receiving an indication from the wireless communication network to the proxy server that the wireless communications device is in the active state" for the similar reasons to those stated above with respect to the claimed steps of terminating and maintaining. Specifically, the steps of establishing and receiving involve indicating that a wireless communication device is in the active state. As described above, Gudjonsson does not disclose indicating that a wireless communication device is in the active state.

For at least the foregoing reasons, Applicant respectfully asserts that claim 1 is patentably distinct from Gudjonsson. Claims 2, 4, 6-10 and 13 depend from claim 1 and therefore enjoy all of the distinctions over the references cited as claim

1. Applicant respectfully requests allowance of claims 1, 2, 4, 6-10 and 13.

2. Independent claim 16, and dependent claims 17-24.

Independent system claim 16 is not anticipated in view of Gudjonsson since Gudjonsson fails to teach or suggest each and every element of independent claim 16. Specifically, claim 16 comprises, *inter alia*,

"a proxy server having a first connection to the wireless communication network for sending and receiving the short messages, and a second connection to the data network for sending and receiving instant messages, wherein the proxy server is logged into the instant messaging service to provide an instant messaging proxy presence for the wireless communications device when the wireless communications device is in the active state status and when the data connection is either active or terminated."

Because Gudjonsson does not teach or suggest the use of a proxy server as claimed by Applicant, Gudjonsson does not anticipate independent claim 16 under 35 U.S.C. 102(e). Claim 16 is a system claim for implementing the patentable method claimed in claim 1. Specifically, the claimed proxy server provides "instant messaging proxy presence for the wireless communications device *when the wireless communications device is in the active state status and when the data connection is either active or terminated.*" (Emphasis added). As described above with reference to claim 1, Gudjonsson does not disclose providing proxy presence when the wireless communication device is in the active state. Applicant respectfully asserts that claim 16 is patentably distinct from Gudjonsson for at least the reasons state above with reference to claim 1.

The Office Action states with reference to claim 16 that “the user’s status of active or terminated would be inherent according to the dynamic status information or presence information.” Applicant respectfully asserts that the Office Action is misconstruing the dynamic statuses of Gudjonsson. As discussed above with reference to claim 1 and Gudjonsson, col. 11, lines 52-57, four states or sub-states are disclosed or suggested by Gudjonsson: (1) online or logged in; (2) offline or logged out; (3) online but preferring not to be contacted; and (4) temporarily unavailable. None of the Gudjonsson states or sub-states corresponds to the claimed active state, as defined by the specification.

Applicant has reviewed the Gudjonsson reference completely, including all of the Gudjonsson citations listed with respect to claim 16. Applicant respectfully asserts that nowhere in the Gudjonsson reference, including the Gudjonsson citations listed with respect to claim 16, are the claimed active state-related limitations of claim 16 suggested or disclosed.

For at least the foregoing reasons, Applicant respectfully asserts that claim 16 is patentably distinct from Gudjonsson. Claims 17-24 depend from claim 16 and therefore enjoy all of the distinctions over the references cited as claim 16. Applicant respectfully requests allowance of claims 16-24.

3. Independent claim 25, and dependent claim 26.

Independent method claim 25 is not anticipated in view of Gudjonsson since Gudjonsson fails to teach or suggest each and every element of independent claim 25. Specifically, claim 25 comprises, *inter alia*,

(a) "communicating an active state status from the wireless communications device to the wireless communication network utilizing at least one connection of the plurality of wireless data connections;"

(b) "terminating the at least one connection upon the establishment of the active state status;"

(c) "providing an instant messaging proxy presence from the proxy server to the instant messaging service upon receipt of the active state status, wherein the proxy server is a stand-in wireless communications device which maintains an online status for sending and receiving instant messages on the data network."

Gudjonsson does not teach the method as claimed in the above listed elements of claim 25. As described above with reference to claims 1 and 16, Gudjonsson does not disclose communicating an active status. Gudjonsson describes other statuses, but not the active status as claimed and defined in the specification.

Applicant respectfully asserts that claim 25 is patentably distinct from Gudjonsson for at least the reasons state above with reference to claims 1 and 16. Applicant has reviewed the Gudjonsson reference completely, including all of the Gudjonsson citations listed with respect to claim 25. Applicant respectfully asserts that nowhere in the Gudjonsson reference, including the Gudjonsson citations listed with respect to claim 25, are the claimed active state-related limitations of claim 25 suggested or disclosed.

For at least the foregoing reasons, Applicant respectfully asserts that claim 25 is patentably distinct from Gudjonsson. Claim 26 depend from claim 25 and

therefore enjoys all of the distinctions over the references cited as claim 25.

Applicant respectfully requests allowance of claims 25 and 26.

**D. New Ground of Rejection**

In section 4 of the Office Action, the Examiner stated that Applicant's arguments with respect to claims 1-2, 4, 6-9, 12, 14, 16-26 have been considered but are moot in view of the new ground(s) of rejection. Applicant respectfully traverses this assertion. No new material was added to the claims as a whole by the amendment dated April 30, 2004. Thus, Applicant's amendment did not necessitate the new ground of rejection. See MPEP § 706.07(a). Applicant respectfully asserts that Applicants remarks presented with the amendment dated April 30, 2004, are not moot.

In section 5 of the Office Action, the Examiner stated that Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Applicant respectfully traverses this assertion. As stated above with respect to section 4 of the Office Action, no new material was added to the claims as a whole by the amendment dated April 30, 2004. Applicant's amendment did not necessitate the new ground of rejection. Applicant respectfully asserts that this Office Action should not have been made final. Applicant respectfully requests reconsideration and withdrawal of the finality of the rejection of the Office Action dated July 27, 2004, under 37 CFR 1.116(c). See MPEP § 706.07(a).

**E. Conclusion**

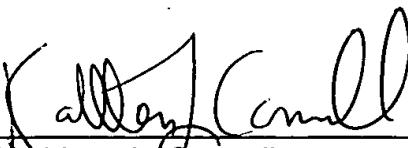
Applicant asserts that the pending claims 1, 2, 4, 6-9, 12, 14 and 16-26 are not anticipated under 35 U.S.C. 102(e) in view of Gudjonsson as Gudjonsson does not teach or suggest each and every element of the pending claims. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims 1, 2, 4, 6-9, 12, 14 and 16-26.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, he is invited to telephone the Attorney for Applicant at the telephone number listed below.

Respectfully submitted,

Dated: August 17, 2004

By:

  
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